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Petitioner's Docket No. 10016958-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Sesek, et al.

Serial No.: 10/052,735

Group Art Unit: To be assigned

Filed: January 18, 2002

Examiner: To be assigned

For: System and Method for Sending Documents

Assistant Commissioner for Patents
Washington, DC 20231

ATTENTION: Director of Office of Initial Patent Examination (M.P.E.P.
§1002.02(q))

PETITION FOR CORRECTION OF INVENTORSHIP OF PATENT APPLICATION
(37 C.F.R. § 1.48(d) and (e))

RECEIVED

NOTE: See § 201.03 of the M.P.E.P. (6th ed., rv. 3)

MAR 31 2003

1. This is a petition for correction of error in a

Technology Center 2100

(check the appropriate item below)

- ☐ misjoinder
☒ nonjoinder

of inventor(s) in the above issued patent. It is respectfully requested that the PTO correct the error in inventorship.

2. Enclosed herewith is (37 C.F.R. §1.48(d)(1) and 1.48 (e)(1),(2)):

- ☒ a statement from a registered attorney of record to correct the inventorship and that identifies the inventor being added and states that the inventorship error occurred without deceptive intention on the part of the omitted inventor; and
☒ a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive invention on his or her part.

4. The fee required (37 C.F.R. §1.17(i)) is paid as follows:

- ☐ Enclosed is a check for \$130.00
☒ Charge Deposit Account 08-2025 \$130.00.



SIGNATURE OF PRACTITIONER

David R. Risley; Reg. No. 39,345

SIGNATURE OF PRACTITIONER

(type or print name of practitioner)

DECLARATION AND POWER OF ATTORNEY
FOR PATENT APPLICATIONATTORNEY DOCKET NO. 10016958-1

As a below named inventor, I hereby declare that
My residence/post office address and citizenship are as stated below next to my name;

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

Systems and Methods for Sending Documents

the specification of which is attached hereto unless the following box is checked:

(X) was filed on 1/18/02 as US Application No. or PCT International Application
Number 10/052,735 and was amended on _____ (if applicable).

I hereby state that I have reviewed and understood the contents of the above-identified specification, including the claims, as amended by any amendment(s) referred to above. I acknowledge the duty to disclose all information which is material to patentability as defined in 37 CFR 1.56.

Foreign Application(s) and/or Claim of Foreign Priority

I hereby claim foreign priority benefits under Title 35, United States Code Section 119 of any foreign application(s) for patent or inventor(s) certificate listed below and have also identified below any foreign application for patent or inventor(s) certificate having a filing date before that of the application on which priority is claimed:

COUNTRY	APPLICATION NUMBER	DATE FILED	PRIORITY CLAIMED UNDER 35 U.S.C. 119
			YES: _____ NO: _____
			YES: _____ NO: _____

Provisional Application

I hereby claim the benefit under Title 35, United States Code Section 119(e) of any United States provisional application(s) listed below:

APPLICATION NUMBER	FILING DATE

U. S. Priority Claim

I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code Section 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, Section 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

APPLICATION NUMBER	FILING DATE	STATUS (patented/pending/abandoned)

POWER OF ATTORNEY:

As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith:

Customer Number 022879

Place Customer
Number Bar Code
Label here

Send Correspondence to:
HEWLETT-PACKARD DEVELOPMENT COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

Direct Telephone Calls To:

Anthony J. Baca
(208) 376-3597

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

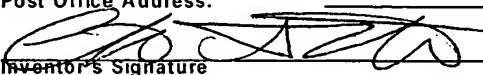
Full Name of Inventor: Robert SesekCitizenship: USResidence: 3277 East Redstone Drive, Boise, ID 83712-8581Post Office Address: same as above2285 NORTH HICKORY WAY, MERIDIAN ID 83642

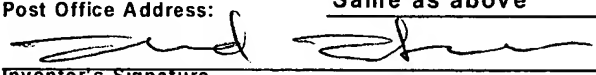
Robert Sesek
Inventor's Signature

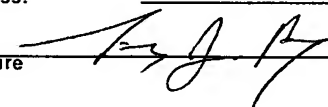
11-MAR-2003
Date

DECLARATION AND POWER OF ATTORNEY
FOR PATENT APPLICATION (continued)

ATTORNEY DOCKET NO. 10016958-1

Full Name of # 2 joint inventor: Chris Struble Citizenship: US
Residence: ~~7280 Hidden Valley Drive, Boise, ID 83709~~ CLS
Post Office Address: Same as above 3742 N Chatterton Way, Boise ID 83713
Inventor's Signature:  Date: 3/11/03

Full Name of # 3 joint inventor: Chad Stevens Citizenship: US
Residence: 1521 W. Alturas ~~SS~~, Boise, ID 83702
Post Office Address: Same as above
Inventor's Signature:  Date: 3/04/2003

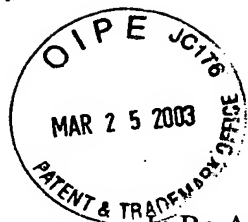
Full Name of # 4 joint inventor: ^{J. Jr.} Travis Parry Citizenship: US
Residence: 4530 N. Lusitano, Boise, ID 83713
Post Office Address: Same as above
Inventor's Signature:  Date: 03/04/2003

Full Name of # 5 joint inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature: _____ Date: _____

Full Name of # 6 joint inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature: _____ Date: _____

Full Name of # 7 joint inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature: _____ Date: _____

Full Name of # 8 joint inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature: _____ Date: _____



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Sesek, et al.

Serial No.: 10/052,735

Filed: January 18, 2002

For: System and Method for Sending
Documents

Group Art Unit: To be assigned

Examiner: To be assigned

Docket No.: 10016958-1

REQUEST FOR CORRECTION OF INVENTORSHIP

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

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Technology Center 2100

Sir:

In regard to the above-noted application, applicant submits the following Request for Correction of Inventorship.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to Deposit Account No. 08-2025.

CERTIFIED MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as "First Class Mail," in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Box Amendment, Washington, D.C. 20231 on March 20, 2003

Signature: Mary Meepun

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I. Statement of Request

Pursuant to 37 C.F.R. § 1.48(a), applicant hereby requests correction of the inventorship of the above-noted patent application (Serial No. 10/052,735). At present, the application names Robert Seseek, Chris Struble, and Chad Stevens as joint inventors of the claimed subject matter. In that Travis J. Parry (hereinafter "Mr. Parry") also contributed to the conception of the claimed subject matter, this Motion seeks to add Mr. Parry as named inventor in the application.

As is discussed below, the original inventorship error occurred without deceptive intention. Included with this Request is an affidavit from the unintentionally excluded inventor, and a newly executed Declaration for Patent Application, and the fee required by 37 C.F.R. § 1.17(i).

II. Statement of Facts

1. The patent application presently names three inventors, Robert Seseek, Chris Struble, and Chad Stevens.

2. Despite not being identified as named inventors upon the filing of the patent application, Mr. Parry contributed to the conception of the subject matter of the patent application.

3. Mr. Parry does not know why he was excluded from the application, however, he avers that the error occurred without any deceptive intention on his part.

III. Statement of the Reasons Why Relief Should Be Granted

The correction of inventorship for U.S. Patent Applications is governed by 37 C.F.R. § 1.48. Under § 1.48, correction of inventorship is permissible if the present designation of inventorship is incorrect due to an error that arose without any deceptive intention on the part of the inventor or inventors that, through error, were not named as inventors. 37 C.F.R. § 1.48(a). Each of these requirements is satisfied in the instant case, as discussed below.

A. The Original Designation of Inventorship is Incorrect

As stated above, the first element to establish before inventorship may be amended is that the original designation of inventorship is incorrect. The case law makes clear that conception is the key to determining inventorship. See Sewall v. Walters, 21 F.3d 411, 415, 30 U.S.P.Q.2d 1356, 1358 (Fed. Cir. 1994) (“Determining ‘inventorship’ is nothing more than determining who conceived the subject matter at issue”); Fina Oil & Chem. Co. v. Ewen, 123 F.3d 1466, 43 USPQ2d 1935 (Fed. Cir. 1997) (“Conception is the touchstone to determining inventorship”). As expressed by the Court of Appeals for the Federal Circuit, although there is no explicit lower limit on the quantum or quality of the inventive contribution for qualification as a joint inventor, a joint inventor “must contribute in some significant manner to the conception of the invention.” Fina Oil, at 1473, 1941 (citations omitted). Furthermore, a person is not a co-inventor if his or her contribution merely equates to an explanation to the actual inventor concepts that are well known in the art. Id.

In the instant case, Mr. Parry clearly contributed to the conception of the claimed invention as evidenced by his declaration.

B. The Original Designation of Inventorship Was Made Without Deceptive Intention

Under Rule 48, the original incorrect designation of inventorship must have occurred due to “error” that arose without “deceptive intention” on the part of the omitted inventor(s). 37 C.F.R. § 1.48(a). It has been long established that the meaning of the term “error” includes not only errors in recordation and transcription, but also errors of judgment, *i.e.*, mistakes. In re Schmidt, 293 F.2d 274, 278, 130 USPQ 404, 408 (C.C.P.A. 1961)(35 U.S.C. § 116 permits correction for bona fide mistakes in joining a person as an inventor). Indeed, with the liberalization of the requirements pertaining to correction of inventorship that has taken place over the latter half of this century, “error” has been construed to include even “gross” misunderstandings of patent law on the part of the inventor's patent attorneys, as long as each misunderstanding was innocent. See Azoplate Corp. v. Silverlith, Inc., 367 F. Supp. 711, 729, 180 U.S.P.Q. 616, 629 (D.C. Del. 1973)(innocent mistakes as to the law made by the inventor's patent attorney qualify as errors under 35 U.S.C. § 116).

Although it is unclear why Mr. Parry was not included as named inventors on this application. In any case, Mr. Parry has averred that this omission occurred without deceptive intention.

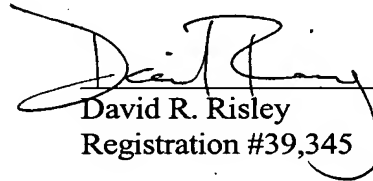
C. The Procedural Formalities of Rule 48 Have Been Satisfied

Included with the present Request is a statement from each person being added as an inventor that the error occurred without deceptive intention on his or her part, a newly executed declaration, and the processing fee set forth in 37 C.F.R. § 1.17(i). Accordingly, each of the requirements of 37 C.F.R. § 1.48(a) has been met.

IV. Conclusion

The instant Request for Correction of Inventorship, and its accompanying exhibits, satisfy the requirements of 37 C.F.R. § 1.48(a). Thus, applicant respectfully requests that Mr. Parry be added as inventor to the instant application.

Respectfully submitted,


David R. Risley
Registration #39,345

Date: 3/20/03




AFFIDAVIT OF TRAVIS PARRY

The undersigned, Travis Parry, declares and states as follows:

1. I am not currently a named inventor of United States Patent Application No. 10/052,735 ("the '735 application"), filed January 18, 2002.
2. Despite not being named as an inventor in the '735 application, I contributed to the conception of the invention claimed in the '735 application.
3. My omission from the inventorship identified in the '735 application was, to my knowledge, a clerical error.
4. In addition, this omission occurred without any deceptive intention on my part.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statement and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.


Travis Parry
J. P.

03/04/2003
Date